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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,479	02/19/2004	Cathy D. Santa Cruz	1068	6814

7590 03/13/2006  
Cathy D. Santa Cruz  
7630 Tholl Drive  
Reno, NV 89506

EXAMINER

NGO, LIEN M

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/782,479

Applicant(s)

SANTA CRUZ ET AL.

Examiner

LIEN TM NGO

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/19/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the accessory adapter in claim 6 being used for the bottle cap and the externally threaded bottleneck in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The accessory adapter in claim 6 is used for the bottle cap and the externally threaded bottleneck in claim 1, which is not supported in the specification.

***Claim Objections***

4. Claim 2 is objected to because of the following informalities: In claim 2, “ (not entered)” should be changed to – (canceled) --. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Schumacher et al. (5,465,835).

In regard to claim 1, Schumacher discloses, in figs. 1 and 12, a bottle-cap comprising: a housing having an upper section 5 and a lower section 6, said lower section having attachment means 14 for attaching said lower section onto an externally threaded bottleneck of a beverage container, said upper section and said lower section being attachable together, said upper section and said lower section in combination providing a protective outer covering for an internal hollow concealed storage compartment B located within said housing, said attachment means 14 including said lower section having a base portion 15 which form a first downwardly facing internally threaded receptacle, said downwardly facing internally threaded receptacle having a mating relationship with said externally threaded bottleneck of said beverage container when threadably interconnected together, said base portion having an upwardly facing hollow neck member 11 which forms said internal hollow concealed storage compartment B therein said upwardly facing hollow neck member having external threads 22 and said upper section 5 forms a second downwardly facing internally threaded receptacle that is of a shape and size to threadably receive and mate with said upwardly facing hollow neck member 11 therein when threadably interconnected together.

In regard to claim 3, Schumacher et al. discloses, in fig. 1, a bottle cap comprising a housing being integrally formed resulting in an upper section 11 and a lower section 15, said lower section of said housing forms a first downwardly facing internally threaded receptacle, said downwardly facing internally threaded receptacle having a mating relationship with an externally threaded bottleneck of a beverage

container when threadably interconnected together, said upper section 11 having an internal hollow concealed storage compartment B formed therein and said internal hollow concealed storage compartment including open/closure means 8.

7. Claims 1, 3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg (Pub. US 2002/0130126).

In regard to claim 1, Rosenberg discloses, in fig. 3, a bottle-cap comprising: a housing having an upper section 12 and a lower section 14, said lower section 14 having attachment means 16 for attaching said lower section onto an externally threaded bottleneck 18 of a container 20 (which is capable of storing a beverage), said upper section and said lower section being attachable together, said upper section and said lower section in combination providing a protective outer covering for an internal hollow concealed storage compartment located within said housing, said attachment means 16 including said lower section having a base portion which form a first downwardly facing internally threaded receptacle, said downwardly facing internally threaded receptacle having a mating relationship with said externally threaded bottleneck of said beverage container when threadably interconnected together, said base portion having an upwardly facing hollow neck member 14 which forms said internal hollow concealed storage compartment B therein said upwardly facing hollow neck member having external threads 18, and said upper section 12 forms a second downwardly facing internally threaded receptacle 16 that is of a shape and size to threadably receive and mate with said upwardly facing hollow neck member 14 therein when threadably interconnected together.

In regard to claim 3, Rosenberg discloses, in fig. 3, a bottle cap comprising a housing being integrally formed resulting in an upper section 14 and a lower section 16, said lower section of said housing forms a first downwardly facing internally threaded receptacle, said downwardly facing internally threaded receptacle having a mating relationship with an externally threaded bottleneck of a container 20 when threadably interconnected together, said upper section 14 having an internal hollow concealed storage compartment formed therein and said internal hollow concealed storage compartment including open/closure means 12.

In regard to claim 7, Rosenberg discloses, in fig. 3, a bottle-cap 14 comprising a housing having an lower section 14, said lower section 14 having attachment means 16 for attaching said lower section onto an externally threaded bottleneck of a container 20, a pre-existing bottle cap 12, said pre-existing bottle cap 12 and said lower section 14 being attachable together, said pre-existing bottle cap 12 and said lower section 14 in combination providing a protective outer covering for an internal hollow concealed storage compartment located within said housings.

8. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Sorenson et al. (6,681,958). Sorenson discloses, in fig. 5b, a bottle cap comprising a housing being integrally formed resulting in an upper section 45 and a lower section 40, said lower section of said housing forms a first downwardly facing internally threaded receptacle 125, said downwardly facing internally threaded receptacle having a mating relationship with an externally threaded bottleneck of a container when threadably

interconnected together, said upper section 45 having an internal hollow concealed storage compartment formed therein and said internal hollow concealed storage compartment including open/closure means 95. The open/closure means is a lid member that is frictionally removably retained with a recess formed within the housing by a sealing flange under the lid member and a hinge 105.

9. Claims 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Willingham et al. (5,769,263). Willingham et al. disclose, in fig. 3, a bottle cap comprising a housing being integrally formed resulting in an upper section 10 and a lower section 14, said lower section of said housing forms a first downwardly facing internally threaded receptacle, said downwardly facing internally threaded receptacle having a mating relationship with an externally threaded bottleneck 22 of a container when threadably interconnected together, said upper section 10 having an internal hollow concealed storage compartment formed therein and said internal hollow concealed storage compartment 16 including open/closure means 18. The open/closure means is a lid member that is frictionally removably retained with a recess formed within the housing by a flange 46.

10. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Bourgeois. (5,287,979). Bourgeois discloses, in figs. 3 and 4, bottle-cap (a combination of member 1 and 2 in fig. 3) comprising a housing having an upper section 2 and a lower section 1, said lower section 1 (fig. 3) having attachment means 3 for attaching said lower section onto an externally threaded bottleneck 4 of a container 2 of fig. 4, said upper section



and said lower section being attachable together, said upper section and said lower section in combination providing a protective outer covering for an internal hollow concealed storage compartment located within said housing, said upper section and said lower section being attachable together by releasable attachment means 7 and 8, said releasable attachment means consisting of said lower section of said housing having at least a first and a second indent 8, said upper section includes at least a first and a second downwardly extending protrusions 7, said first indent 8 being of a shape and size to fictionally receive said first downwardly extending protrusion 7 therein and said second indent being of a shape and size to fictionally receive said second downwardly extending protrusion therein (see col. 2, lines 51-53).

11. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Yuichi Nakata (3,348,716). Nakata discloses, in figs. 1 and 2, a bottle-cap 13 comprising a housing having an lower section, said lower section having attachment means 21 for attaching said lower section onto an externally threaded bottleneck of a container 12, a pre-existing bottle cap 14, said pre-existing bottle cap 14 and said lower section being attachable together, said pre-existing bottle cap 14 and said lower section in combination providing a protective outer covering for an internal hollow concealed storage compartment located within said housings.

### ***Response to Arguments***

12. Applicant's arguments filed 11/14/05 have been fully considered but they are not persuasive as pointed out in the rejections above.

Examiner further notes that the recitation of intended use of a bottle-cap for a beverage container has been carefully considered, but deemed not to impose any structural limitations on the claims distinguishable over the bottle-cap of the applied prior art above. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structure limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987)

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIEN TM NGO whose telephone number is 571-272-

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4545. The examiner can normally be reached on Monday through Friday from 8:30 AM -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL MAR can be reached on 571-272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LIEN TM NGO  
Primary Examiner  
Art Unit 3754

January 26, 2006

